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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/709,242

04/23/2004

Jeffrey Kaplan

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MALIN HALEY AND DIMAGGIO, PA  
1936 S ANDREWS AVENUE  
FORT LAUDERDALE, FL 33316

EXAMINER

HUYNH, KHOA D

ART UNIT

PAPER NUMBER

3751

MAIL DATE

DELIVERY MODE

10/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/709,242	<b>Applicant(s)</b> KAPLAN, JEFFREY	
	<b>Examiner</b> Khoah D. Huynh	<b>Art Unit</b> 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) 16, 17, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12-15 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the retention ribs 18 as described in the amended specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

2. The amendment filed 06/17/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the retention ribs 18.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "the means for sealing". There is insufficient antecedent basis for this limitation in the claim and therefore, render the claim indefinite

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 12-15 and 18, as presently understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Lombardi et al. (5342134).

Regarding claim 1, the Lombardi et al. reference discloses a lipstick or lip balm dispenser capable of being used to heal chapped lips (*i.e. dried, cracked and sometimes bleeding lips*) to apply moisture and prevent the lips from bleeding due to its chapped conditions. The dispenser includes a pencil (30) having a pre-determined diameter and a tip, and a pencil holder (Fig. 1). The holder includes an annular tubular base (Fig. 8) having cylindrical cavity sized in diameter approximately equal to the pencil diameter to retain the pencil, an inner retainer sleeve (Fig. 5) having a top end, the sleeve located generally circumferentially around the base. The dispenser also includes actuator for adjusting (10, 1) the distance of the base retaining the styptic pencil to the top end of the retainer sleeve located around the base located at the bottom end of the dispenser allowing the tip only to be exposed for use; and a sealable cap (at 4 and 105 in Fig. 4) sized to fit snug with and over the retaining sleeve to prevent the pencil from receiving additional moisture from the outside air.

Regarding claim 2, wherein the base has at least one rib (20) for holding the styptic pencil.

Regarding claim 3, wherein the means for adjusting comprises an outer generally cylindrical shell (10 in Fig. 6) located peripherally around the inner retainer sleeve, whereby the inner retainer sleeve is rotatable within the outer shell.

Regarding claim 4, wherein the means for adjusting further comprises a rotatable grip (1), whereby the distance of the base to the inner retainer sleeve is adjusted by the rotation of the grip.

Regarding claims 5 and 6, wherein the base further includes at least one protrusion (16), the inner retainer sleeve includes a vertical slot (14) having a bottom endpoint and a top endpoint, and the outer shell includes at least one helical depression (18) at least partway through the outer shell, whereby the protrusion engages both the slot and the depression and whereby the base is elevated and lowered by movement of the means for adjusting, and wherein the engagement of the protrusion with the slot and the depression limit the adjustment distance of the base.

Regarding claim 12, the cap further comprises a means for sealing moisture or wetness from the pencil, wherein the means for sealing comprises at least one annular seal (at 112).

Regarding claim 13, wherein the cap is inherently frictionally engaged with the means for adjusting, whereby the pencil is protected from moisture.

Regarding claim 14, wherein the tolerance of the fit of the cap inherently enhances the protection of the pencil against moisture.

Regarding claim 15, the dispenser further comprises protrusions (112,108) for engagement with the cap whereby exposure of the pencil to moisture is inherently decreased when the cap is in place.

Claim 18 recites limitations that substantially similar to the limitations recited in claim 1 which has been rejected as discussed supra.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lombardi et al. (as discussed supra).

Even though the Lombardi et al. reference does not specifically disclose that the pencil comprises water soluble resin, polyethylene glycol and glycerine as claimed, it, however, would have been obvious to one of ordinary skill in the art to employ such components for the pencil or lipstick composition. Such modification would be considered a mere choice of a preferred components for the pencil or lipstick composition that is suitable with cosmetic products, especially since the Lombardi et al. reference also discloses that the composition include de various water soluble components, single or mixtures of oils, and emulsifier (col. 3, lines 1-35). In other words, the use of a specific components for making the styptic pencil or lipstick would have been an “obvious to try” approach since the use of water soluble resin, polyethylene glycol and glycerine to form a cosmetic composition is not of innovation but of ordinary skill and common sense. *KSR, 550 U.S. (2007)*.

***Response to Amendment***

9. Applicant's amendment, filed on 06/17/08, to the pending claims is insufficient to distinguish the claimed invention from the cited prior art or overcome the rejections as discussed above.

***Response to Arguments***

10. Also, applicant's arguments filed on 06/17/2008 with respect to the pending claims have been fully considered. However, they are deemed not persuasive.

Applicant asserts that the Lombardi et al. reference is not for a styptic pencil. See Remarks section, page 8. The examiner disagrees.

The term "styptic pencil" is a functional recitation, and the functional recitation of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the recited function, then it meets the claim. In this instant, the pencil of the Lombardi et al. reference is capable of being used to apply to small wounds (*i.e. dried, cracked and sometimes bleeding lips*) and therefore, the Lombardi et al. reference meets the claims. Furthermore, it is noted that the features upon which applicant relies (*i.e., a cylindrical stick of paste vehicle medicated with a styptic substance as alum and applied to small wounds to stop bleeding*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant also asserts that the Lombardi et al. reference does not teach a moisture seal. See Remarks section, pages 8-9. The examiner disagrees.

As stated in the above rejection, the Lombardi et al. reference does teach a sealable cap sized to fit snug with and over the retaining sleeve to prevent the pencil from receiving additional moisture from the outside air. Therefore, the Lombardi et al. reference meets applicant's invention as claimed.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-3:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khoa D. Huynh/  
Primary Examiner, Art Unit 3751